

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 24

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte JOHN T. HASTINGS

Appeal No. 2001-1301
Application 08/867,949

ON BRIEF

Before FRANKFORT, MCQUADE, and CRAWFORD, Administrative Patent Judges.

MCQUADE, Administrative Patent Judge.

DECISION ON APPEAL

John T. Hastings appeals from the final rejection (Paper No. 18) of claims 39, 40, 43 and 46, all of the claims pending in the application.

This is the second appeal to this Board involving the instant application. In a decision (Paper No. 16) rendered in the first appeal (Appeal No. 1999-2757), the Board determined that the appellant's claims were indefinite and lacking in written descriptive support, entered corresponding 35 U.S.C. § 112, first and second paragraph, rejections, and reversed the

examiner's 35 U.S.C. § 103(a) rejection because the claim indefiniteness prevented a reasoned evaluation thereof. The appellant has since amended the claims to overcome the § 112 rejections and the examiner has reinstated the § 103(a) rejection which is now before us for review.

THE INVENTION

The invention relates to "a display holder for holding and displaying sheets of paper or similar material" (specification, page 1). Representative claim 39 reads as follows:

39. A unitary display frame for displaying a document on a fabric covered surface comprising:

a cover having a front side, a rear side, a transparent central portion, and an opaque peripheral portion; and

attachment means secured to said rear side of said opaque peripheral portion of said cover for selectively engaging the fabric of the fabric covered surface and supporting the document in a defined retention area, between said cover and the fabric of the fabric covered surface, for limiting relative movement between the document and said cover.

THE PRIOR ART

The prior art relied on by the examiner as evidence of obviousness consists of:

The "Easyboard Presentation Holder" product and description sheets made of record by the appellant in an information disclosure statement filed August 22, 1997, Paper No. 2 (Easyboard).¹

¹ Although the "Easyboard Presentation Holder" materials do not bear a distribution or publication date, the appellant acknowledges in the information disclosure statement that they

THE REJECTION

Claims 39, 40, 43 and 46 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Easyboard.

Attention is directed to the appellant's main and reply briefs (Paper Nos. 20 and 22) and to the examiner's answer (Paper No. 21) for the respective positions of the appellant and the examiner regarding this rejection.²

DISCUSSION

The description sheets characterize the Easyboard product as comprising "[a] clear, matte, no glare film attached on all four sides by Velcro to a rigid, lightweight, white core board for presentations, posters, exhibits, charts, blueprints, maps or signage." The film and board are rectangular in shape, and the film, which can be written on with an erasable marker, has an opaque printed border simulating a picture frame. The VELCRO® elements comprise four strips of hook-type fasteners extending along the rectangular periphery of the core board and four mating strips of loop-type fasteners extending along the rectangular

are prior art relative to the claimed invention.

² As noted by the examiner on page 2 in the answer, the term "said frame means" in claim 40 lacks a proper antecedent basis and should be changed to --said cover-- in the event of further prosecution.

periphery of the film behind the opaque border. The strips cooperate to selectively attach the film to the board with a document affixed therebetween.

The film component of the Easyboard product constitutes a display frame meeting all of the limitations in the appealed claims except for the one in independent claim 39 requiring the attachment means to be capable of selectively engaging the fabric of a fabric covered surface and the one in dependent claim 43 further defining the attachment means as comprising hook-type fasteners. As indicated above, the attachment means on the Easyboard film are loop-type fasteners. The record is devoid of any evidence that these loop-type fasteners are capable of selectively engaging a fabric, or that the hook-type fasteners which they do selectively engage comprise a fabric as urged by the examiner (see pages 5 and 6 in the answer).

The appellant's arguments that the Easyboard product is further deficient with respect to the subject matter claimed because (1) it is not used in combination with a fabric covered wall, (2) it is a two-piece holder which does not meet the "unitary" limitations in claims 39 and 40 or the "flexible" limitation in claim 40, and (3) its attachment means has four sections rather than "three" as recited in claim 43 are

unpersuasive, essentially because they are not commensurate with the actual scope of the appealed claims. To begin with, these claims recite a display frame per se, not a display frame in combination with a fabric covered surface and not a method of using a display frame with such a surface. Although utilized together, the Easyboard film and core board are separate and distinct elements, and the film alone embodies a "unitary" display frame comprising attachment means and a "unitary" and "flexible" cover. Finally, claim 43 is an open-ended "comprising" claim which covers, i.e., does not exclude, additional unrecited elements (see AFG Industries Inc. v. Cardinal IG Co., 239 F.3d 1239, 1244-45, 57 USPQ2d 1776, 1780-81 (Fed. Cir. 2001)), such as the fourth attachment means section on the Easyboard film component.

As for the above noted failure of the Easyboard product to meet the limitation in claim 39 requiring the attachment means to be capable of selectively engaging the fabric of a fabric covered surface and the limitation in claim 43 further defining the attachment means as comprising hook-type fasteners, the examiner has concluded (see page 5 in the answer) that it would have been an obvious matter of design choice to switch the positions of the Easyboard hook-type and loop-type fasteners, with the hook-like

fasteners thus being placed on the film. As so modified, the film would have hook-type fasteners as recited in claim 43 which are inherently capable of selectively engaging the fabric of a fabric covered surface as recited in claim 39. The appellant counters that there is no motivation or suggestion for this modification, and that it therefore rests on impermissible hindsight.

The assessment of this obviousness issue must take into account the skill that must be presumed on the part of the artisan (see In re Sovish, 769 F.2d 738, 743, 226 USPQ 771, 774 (Fed. Cir. 1985)), the common knowledge and common sense of such a person (see In re Bozek, 416 F.2d 1385, 1390, 163 USPQ 545, 549 (CCPA 1969)), and, in addition to the specific teachings of the prior art, the inferences which the artisan would reasonably be expected to draw therefrom (see In re Preda, 401 F.2d 825, 159 USPQ 342, 344 (CCPA 1968)). Viewed in this light, the examiner's conclusion of obviousness is well taken. One of ordinary skill in the art, considering the Easyboard product as a whole, including its structure and intended use, would not attach any significance to whether the loop-type and hook-type fasteners were disposed on the film and core board, respectively, or on the core board and film, respectively, and therefore would consider

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either placement to be an obvious matter of design choice. Thus, the Easyboard product, seen through the eyes of a person having ordinary skill in the art, would have suggested a film component having hook-type attachment means. Such a film component would respond to all of the display frame limitations in the appealed claims. In this regard, it is again pointed out that these claims are drawn to a display frame per se, and not to a display frame in combination with a fabric covered surface or to a method of using a display frame with such a surface.

We shall therefore sustain the standing 35 U.S.C. § 103(a) rejection of claims 39, 40, 43 and 46.

SUMMARY

The decision of the examiner to reject claims 39, 40, 43 and 46 is affirmed.

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No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

AFFIRMED

CHARLES E. FRANKFORT)	
Administrative Patent Judge)	
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)	APPEALS AND
JOHN P. MCQUADE)	
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MURRIEL E. CRAWFORD)	
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